UNITED STATES PATENT AND TRADEMARK OFFICE

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09/388,191	09/01/1999	MARK G. DREYER	27600/M195A	3487

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>14 March 2007</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-26</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-26</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the amendment filed on 3/14/2007.

This action is made Final.

2.   In the amendment, claims 1-26 are pending in the case. Claims 1, and 16 are independent claims.

Drawings

3.   This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 10-11, and 23-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 10, and 23 recite "a third plurality of pages" line 2. The Examiner failed to find a content describing a third set or plurality of pages in a book, in the specification.

6.   Claims 11, and 24 recite "a fourth plurality of templates" lines 2-4. The Examiner failed

to find a content describing a fourth set or plurality of templates, in the specification.

7.   Claims 10-11, and 23-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains,

or with which it is most nearly connected, to make and/or use the invention.

8.   Claims 10, and 23 recite "a third plurality of pages" line 2. The Examiner failed to find a

content describing how to implement a third set or plurality of pages in a book, in the

specification.

9.   Claims 11, and 24 recite "a fourth plurality of templates" lines 2-4. The Examiner failed

to find a content describing how to implement a fourth set or plurality of templates, in the

specification.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11.   Claims 1-3, 5-9, and 11-26 remain rejected under 35 U.S.C. 102(e) as being anticipated

by Nehab et al, hereinafter Nehab (USPat.# 6,029,182, 2/2000, filed on 10/1996).

Regarding independent claim 1, Nehab discloses a user creating or editing a personal

news profile template for generating a personalized newspaper-- a first routine that provides for

generation of a template (col.9, lines 35-67).

Additionally, Nehab discloses retrieving information from an html web page, and storing

it in a flattened document. The data in the flattened document, which includes records, and

fields--articles headings, text, etc.— *a second routine that provides for extraction of data from*

the first page description file to database for storing the data indicative of the portions of the

first page description file-- is used for creating a personalized formatted newspaper according to

the template's layout commands-- *a third routine that generates the second page description*

file from the template and the database; wherein the first page description file includes at least

layout information for at least one page, and the database comprises a first plurality of records

and a second plurality of fields (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67).

Regarding claim 2, which depends on claim 1, Nehab discloses a user creating or editing

a personal news profile template for generating a personalized newspaper (col.9, lines 35-67).

Regarding claim 3, which depends on claim 2, Nehab discloses a user uses a gui for

creating or editing a personal news profile template for generating a personalized newspaper

(col.9, lines 35-col.10, line 67).

Regarding claim 5, which depends on claim 1, Nehab discloses a user uses a gui for

creating or editing a personal news profile template, which specifies the layout, and allows for

the generation a personalized newspaper (col.9, lines 35-col.10, line 67).

Regarding claim 6, which depends on claim 1, Nehab discloses a system utilized by a

user for retrieving news articles from an html web page, and storing it in a flattened document.

The articles in the flattened documents are used for creating a personalized formatted newspaper

according to the template's layout commands for each article— *the second routine provides a*

user interface for characterizing each portion of the portions of the first page description file as

an instance of at least one of the fields of the second plurality of fields of the database-- (col.3,

lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67).

Regarding claim 7, which depends on claim 1, Nehab discloses retrieving news articles

from an html web page, and storing it in a flattened document. (col.3, lines 15-67, col.12, lines 1-

16, 40-64, col. 7, lines 23-67). In other words, the web page is parsed, and the articles are

extracted from the markup language.

Regarding claim 8, which depends on claim 7, Nehab discloses retrieving news articles from an html web page, and storing it in a flattened document. (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67). In other words, the web page is parsed, and the articles are extracted from the markup language—*content and control data.*

Regarding claim 9, which depends on claim 8, Nehab discloses retrieving news articles from an html web page, and storing them in a flattened document, and then formatting them according to the template created with the gui (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67). In other words, the web page is parsed, and the articles are extracted from the markup language.

Regarding claim 12, which depends on claim 1, Nehab discloses retrieving news articles from an html web page, and storing them in a flattened document, and then formatting them according to the template created with the gui. The data retrieved can consist of various supported images (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67, col. 24, lines 53-59).

Regarding claim 13, which depends on claim 12, Nehab discloses retrieving news articles from an html web page, and storing it in a flattened document, and then formatting them according to the template created with the gui. The data retrieved can consist of various supported images (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67, col. 24, lines 53-59).

Regarding claim 14, which depends on claim 1, Nehab discloses retrieving news articles from an html web page, and storing them in a flattened document according to the template created with the gui (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67, col. 24, lines 53-59).

Regarding claim 15, which depends on claim 14, Nehab discloses retrieving news articles from an html web page, and storing them in a flattened document , and then formatting them to one's liking using gui (col.3, lines 15-67, col.4, lines 39-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67, col. 24, lines 53-59).

Claims 16-21, 25-26 are directed towards a method for implementing the system found in claims 1, 3, 5-8, 12, and 14 respectively, and therefore are similarly rejected.

Claim 22 is directed towards a method for implementing the system found in claim 1, and therefore is similarly rejected.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13.   Claim 4 remains, and claims 11, and 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Nehab.

Regarding claim 4, which depends on claim 1, Nehab discloses retrieving information

from an html web page, and storing it in a flattened document. The data in the flattened

document is used for creating a personalized formatted newspaper according to the template's

layout commands (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67). Nehab fails

to explicitly disclose: *page make-up software application comprises QuarkXPress*. However, it

would have been obvious to a person of ordinary skill in the art at the time of the invention to

have included QuarkXPress, because of all the reasons found in Nehab, including allowing a user

to retrieve hypermedia documents and then format, so that a user could scan and read them in a

natural fashion (col.2, lines 40-67). Thus, providing the benefit of creating a personalized

document that allows a user to look at the sections he finds interesting, and grab his attention

using an application, and format such as the provided by *QuarkXPress*.

Regarding claim 11, which depends on claim 1, Nehab discloses retrieving news articles

from an html web page, and storing it in a flattened document, and then formatting them

according to one of the templates created with the gui (col.3, lines 15-67, col.12, lines 1-16, 40-

64, col. 7, lines 23-col.8, line 45). Nehab fails to explicitly disclose: *fourth plurality of templates*.

However, it would have been obvious to a person of ordinary skill in the art at the time of the

invention to have included many sets of templates, because of all the reasons found in Nehab,

including allowing many users to retrieve hypermedia documents and then format, so that the

users could scan and read them in a natural fashion (col.2, lines 40-67). Thus, providing the

benefit of creating a personalized document that allows users to look at the sections they find

interesting, and grab their attention.

Claim 24 is directed towards a method for implementing the system found in claim 11,

and therefore is similarly rejected.

14.   Claims 10, and 23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over

Nehab, in view of Mastie (Pat. # 6,480,866, 11/12/02, filed on 6/30/98).

Regarding claim 10, which depends on claim 1, Nehab discloses a user creating or editing

a personal news profile template for generating a personalized newspaper (col.9, lines 35-67).

Nehab fails to explicitly disclose: *plurality of pages to be printed in a book*. However, Mastie

teaches the printing of a plurality of pages in a book (c.4,L.14-67). It would have been obvious to

a person of ordinary skill in the art at the time of the invention to have combined the teachings of

Nehab, and Mastie, because of all the reasons found in Mastie above including the creation of a

book onto a single document which can be printed, stored, retrieved, etc., and because of all the

reasons found in Nehab, including allowing many users to retrieve hypermedia documents and

then format, so that the users could scan and read them in a natural fashion (col.2, lines 40-67).

Thus, providing the benefit of creating a personalized document that allows users to look at the

sections they find interesting, and grab their attention.

Claim 23 is directed towards a method for implementing the system found in claim 10,

and therefore is similarly rejected.

Response to Arguments

15.   Applicant's arguments filed 3/14/2007 have been fully considered but they are not

persuasive in light of the rejection above. The Applicant indicates that Nehab

Nehab includes no teaching of a second routine for extraction of data from a file of a first page

that has portions that include content, which data are indicative of the portions and are used to

generate a database where the data are stored. Moreover, Nehab does not disclose a database that

includes a plurality of records and fields. Yet another deficiency of Nehab is its lack of teaching

regarding the layout information of the data as it exists on the page from which it was extracted.

The claimed invention, in contrast, recites that the first page description file includes "at least

layout information for at least one page" (claims 1 and 16) page 7 last parag. The Examiner

disagrees, because Nehab discloses retrieving information from an html web page, and storing it

in a flattened document. The data in the flattened document, which includes records, and fields--

articles headings, text, etc.— *a second routine that provides for extraction of data from the first*

page description file to database for storing the data indicative of the portions of the first page

description file-- is used for creating a personalized formatted newspaper according to the

template's layout commands-- *a third routine that generates the second page description file*

from the template and the database; wherein the first page description file includes at least

layout information for at least one page, and the database comprises a first plurality of records

and a second plurality of fields (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67).

The Applicant indicates that neither Simpson, nor Hohensee teach the invention (pages 8-

9). There was a mistake in the heading, since it was not updated to reflect that claim 4 was

rejected as being obvious in light of Nehab alone. As shown by the rejection of the claim, it is

Nehab by itself that was being relied upon, and not Simpson or Hohensee.

In response to applicant's argument that Nehab is nonanalogous art (page 9, parag.3), it

has been held that a prior art reference must either be in the field of applicant's endeavor or, if

not, then be reasonably pertinent to the particular problem with which the applicant was

concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re*

Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Nehab teaches

producing a markup language document—*page description file--*, which is extracted from other

hypermedia documents over the Internet (col.3, lines15-67, col.7, lines 23-67, and fig.3d).

Therefore, Nehab is in the field of creating page description files recited by Applicant.

In response to applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e., "the present

invention relates to a method and system for automated production of a customized page

description file. The customized page description file is generated irrespective of the source of a

first page description file from which data are extracted for the customized one. See specification

at 1-3. The "finding" or "retrieving" of the first page description file is not at issue in the present

invention; rather, making use of the data included in that file is" page 9, parag.3) are not recited

in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Applicant is welcome to insert this limitation

into the claimed subject matter, if it is so desired.

The Applicant submits that Nehab teaches away from the claimed invention, because

Nehab teaches data exclusion from the final hypermedia document, whereas the invention

contains no data exclusion (page 10, parag 2). The Examiner disagrees, because the invention as

claimed recites the extraction of data from a database—data exclusion— (claim 1).

Furthermore, the Applicant indicates that Nehab nor Mastie teach or suggest extracting

data from a page description file to generate a database (page 11). The Examiner disagrees,

because Nehab discloses a user creating or editing a personal news profile template for

generating a personalized newspaper (col.9, lines 35-67).

Conclusion

16.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

I.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner

can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please

allow at least one business day.

Information regarding the status of an application may be obtained from the Patent

Application Retrieval (PAIR) system. Status information for published applications may be

obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, go to http://portal.uspto.gov/external/portal/pair. Should you have any questions about

access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866

217-9197 (toll-free).

Any response to this Action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Or faxed to:

- **(571)-273-8300** (for **all** Formal communications intended for entry)

CESAR PAULA
PRIMARY EXAMINER
5/25/2007